

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

MAILED

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U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD L. PALINKAS

Appeal No. 2004-1395
Application No. 09/407,053

ON BRIEF

Before COHEN, NASE, and BAHR, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 3, 5 to 8, 10 to 15 and 17 to 22, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellant's invention relates generally to springs and is more specifically directed to devices that dampen lateral rolling motions that occur during the movement of railroad cars (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Magowan	136,079	Feb. 18, 1873
Platkiewicz et al. (Platkiewicz)	4,465,799	Aug. 14, 1984
Carlston	4,998,997	Mar. 12, 1991
Curtis et al. (Curtis)	5,036,774	Aug. 6, 1991
Spencer et al. (Spencer)	5,086,707	Feb. 11, 1992

Claims 15, 19 and 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Carlston in view of Magowan.

Claims 1, 3, 5 to 8, 10 to 14, 17, 18, 21 and 22 stand rejected under 35 U.S.C. § 103 as being unpatentable over Carlston in view of Magowan in view of Platkiewicz and further in view of Curtis and Spencer.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the final rejection (Paper No. 18, mailed November 19, 2002) and the answer (Paper No. 23, mailed May 6, 2003) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 22, filed April 17, 2003) and reply brief (Paper No. 24, filed July 3, 2003) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1, 3, 5 to 8, 10 to 15 and 17 to 22 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is

established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention.

See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Claims 15, 19 and 20

Claim 15 reads as follows:

A bearing pad assembly comprising:
a first housing having a bore extending through said first housing;
a first load bearing member coupled to said first housing and defining an abutment surface opposite to said first housing;
a second housing having a bore extending through said second housing, adapted to telescopically receive said first housing;
a second load bearing member coupled to said second housing and defining an abutment surface opposite to said second housing; and
at least one compression spring in the shape of a toroid positioned within said first housing bore, the toroid having an outside diameter minus an inside diameter equal to or greater than a height when positioned in the bearing pad assembly.

Carlston's invention relates to railroad cars and particularly to articulated railroad cars and to side bearing units used therewith. A side bearing unit is attached to the bolster of each truck thereby regulating independent movement of the body of the car and impeding truck hunting. Side bearing units have been used to regulate movement between the body of a railroad car and the trucks for a substantial period of time.

Carlston's side bearing unit 30 is shown in Figures 2, 4, 5 and 6. The side bearing unit 30 includes a round top cap 32, a housing 34 and first and second thermoplastic elastomeric springs 36 and 38. The generally round top cap 32 includes a top surface 40, a downwardly depending integrally formed side wall 46 and a bottom surface 48 having a centrally located integrally formed depending secondary solid stop 50 and a primary stop surface 52. A housing 34 includes a base portion 56, an integrally formed upwardly extending side wall 60 which includes a primary stop portion 62 and an integrally formed upwardly extending secondary stop 66 that cooperates with the depending secondary stop 50. The housing 34 fits within the round top cap 32 creating an internal void 68.

Carlston's first and second thermoplastic elastomeric springs 36 and 38 are situated within internal void 68 in a piggyback position. Both thermoplastic elastomeric springs are identical and by placing them in series, the available travel of the side bearing can be doubled and the spring rate cut in half. The two elastomeric springs are separated by a plate 75 and both are mechanically locked to the plate by pins 77, thus forming an elastomer spring assembly. Referring to Figure 7, it is apparent that the elastomeric spring is an open-ended hollow tube. The thermoplastic elastomer spring 36 is designed to fold and flex as it is subjected to a work cycle. Carlston teaches (column 4, lines 15-22) that

the elastomeric spring is so designed so that throughout its total travel from free height, it is folding and flexing rather than compressing. The loaded area remains essentially the same throughout its total travel. This is accomplished by designing the pre-formed thermoplastic elastomeric spring so that the outside diameter minus the inside diameter is less than the solid height within the side bearing.

Magowan's invention relates to a spring for a railroad car. As shown in Figures 1-2, the spring includes a central cylindrical core A of India rubber, two surrounding rings B of India rubber having a circular cross-section, a box D surrounds the rings B and a follower C of corresponding configuration with the interior of the box so as to form an opposite bearing for the spring. Magowan teaches that his spring has a high degree of elasticity, great bearing strength and may be manufactured with great economy.

After the scope and content of the prior art are determined, the differences between the prior art and the claims at issue are to be ascertained. Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

Based on our analysis and review of Carlston and claim 15, it is our opinion that the only difference is the limitation that the toroid spring has an outside diameter minus an inside diameter equal to or greater than a height when positioned in the bearing pad assembly.

In our view, the combined teachings of Carlston and Magowan would not have led one of ordinary skill in the art to have modified Carlston to arrive at the claimed invention for the reasons set forth by the appellant in the briefs. We fail to find sufficient motivation in the teachings of Magowan for one skilled in the art not to follow the specific teachings of Carlston that the elastomeric spring fold and flex rather than compress and that the outside diameter minus the inside diameter of the spring is less than the solid height of the spring. As such, we conclude that it would not have been obvious at the time the invention was made to a person of ordinary skill in the art from the combined teachings of Carlston and Magowan to have modified the toroid springs of Carlston to have an outside diameter minus an inside diameter equal to or greater than a height when positioned in the bearing pad assembly.¹

For the reasons set forth above, the decision of the examiner to reject claim 15, and claims 19 and 20 dependent thereon, under 35 U.S.C. § 103 is reversed.

Claims 1, 3, 5 to 8, 10 to 14, 17, 18, 21 and 22

We have reviewed the references to Platkiewicz, Curtis and Spencer additionally applied in the rejection of claims 1, 3, 5 to 8, 10 to 14, 17, 18, 21 and 22 but find

¹ The mere fact that the prior art could be modified in the manner suggested by the Examiner does not make such a modification obvious unless the prior art suggested the desirability of the modification. See In re Gordon, 773 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

nothing therein which makes up for the deficiencies of Carlston and Magowan discussed above with respect to claim 15. Independent claim 1, the only other independent claim on appeal, contains the same limitations as claim 15 not suggested by the combined teachings of Carlston and Magowan. Accordingly, we cannot sustain the examiner's rejection of appealed claims 1, 3, 5 to 8, 10 to 14, 17, 18, 21 and 22 under 35 U.S.C. § 103.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 3, 5 to 8, 10 to 15 and 17 to 22 under 35 U.S.C. § 103 is reversed.

REVERSED



IRWIN CHARLES COHEN
Administrative Patent Judge



JEFFREY V. NASE
Administrative Patent Judge



JENNIFER D. BAHR
Administrative Patent Judge

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